

REMARKS

Claims 1, 2 and 13 are pending. Claims 5-11 are cancelled herein without prejudice or disclaimer. Claims 1 and 2 are amended herein. Support for the amendments is detailed below.

Applicants' Response to the Claim Rejections under 35 U.S.C. § 112

Claim 2 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, the rejection asserts that "said second support" of claim 2 lacks antecedent basis because claim 1 was amended to recite "a pair of second support." In response thereto, applicants have amended claim 2 to adopt the Examiner's suggestion.

Applicants' Response to the Claim Rejections under 35 U.S.C. §103(a)

Claims 1, 2 and 5-12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Spear* (US 6,075,800) in view of *Gen-Ei* (US 6,618,420).

Applicants respectfully submit that the present invention as now claimed is not obvious in light of the combination of *Spear* and *Gen-Ei* because the combination does not provide for all the claimed features, nor is there any reason prompting a skilled artisan to modify the combinations to result in the claimed invention.

Specifically, the combination at least fails to provide for the disclosure of parent claim 1 that a ratio of an area of the first and second supports relative to an area of the semiconductor laser element is set within a range from more than 33% to less than 52%.

The current rejection addressing the ratio previously presented in dependent claim 11 acknowledges that the combination of references does not explicitly teach the ratios of areas and widths of the supports. The rejection cites to col. 2, lines 23-25 of Spear which disclose that the solder strips have a function to provide mechanical stability and additional thermal conduction paths. The rejection further asserts that it is known in the art to increase contact area to improve thermal conduction (citing US PG Pub 2002/0024985) and a skilled artisan would adjust the size of the supports accordingly. See pages 4-5, sections 13-16 of the present Office Action.

As set forth in *Takeda v. Alphapharm* 492 F.3d 1350, 1356-1357; 83 USPQ2d 1169 (Fed. Cir. 2007):

While the *KSR* Court rejected a rigid application of the teaching, suggestion, or motivation ("TSM") test in an obviousness inquiry, the Court acknowledged the importance of identifying "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does" in an obviousness determination. *KSR*, 127 S. Ct. at 1731.

In the current instance there is no viable reason whereby a skilled artisan would modify the combination of Spear and Gen-Ei, to adopt a range that is not greater than 52 or 50%. Applicants respectfully note that although Spear and US PG Pub 2002/0024985 might suggest that the increase in contact area is beneficial for heat radiation, it is never suggested that the contact area should not be greater than 52 or 50% to retain the area to be used for etching process

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observation. As such, there is no viable reason whereby a skilled artisan would combine the elements of the prior art as set forth in claim 1.

Wherefore, applicants respectfully submit that the present invention pursuant to claim 1 and its respective dependent claims is not obvious under 35 U.S.C. §103(a).

Claims 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Spear in view of Gen-Ei and further in view of US Patent 6,199,561 (Mitsubishi).

Claim 13 depends from claim 1. Therefore by addressing the rejection of parent claim 1 as detailed above, likewise the rejection of claim 13 should be considered addressed.

In view of the aforementioned amendments and accompanying remarks, Applicants submit that the claims, as herein amended, are in condition for allowance. Applicants request such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicants' undersigned attorney to arrange for an interview to expedite the disposition of this case.

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If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP

A handwritten signature in black ink, appearing to read "Michael J. Caridi", with a long horizontal flourish extending to the right.

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